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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,299	08/30/1999	ALI MOSLEH	93-3-513	8955
25537	7590	09/10/2007		
VERIZON PATENT MANAGEMENT GROUP 1515 N. COURTHOUSE ROAD SUITE 500 ARLINGTON, VA 22201-2909			EXAMINER RIMELL, SAMUEL G	
			ART UNIT 2164	PAPER NUMBER
			NOTIFICATION DATE 09/10/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

## Office Action Summary

Application No.

09/385,299

Applicant(s)

MOSLEH ET AL.

Examiner

Sam Rimell

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2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 30-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4,32 and 33 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-17, 30, 31, 34-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 5-17, 30-31 and 34-54 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 7, 12, 30, 36 and 41: Each of these claims have be amended to recite the phrase “..medium that is selected by the portable access device based on the communication profile...”. The original specification does not support the concept of making the selection of the medium based on a communication protocol. The relevant discussion appears in the specification at page 9, where it states:

*The actual selection of a particular channel will be service dependent and a function of the user's whereabouts, the desired quality of the connection, and the costs of the connection. One of the elements used to determine the selection of a specific channel for communications, either local or wide area, is the available network and its coverage area. The selection will also depend on the destination server's configuration which may include: in campus wired Ethernet LANs, hospital wide wireless Ethernet, wide area wireless networks, and the Public Switched Telephone Network (PSTN) connections using standard modems.*

The first sentence makes no mention of using a communications profile as a factor in the selection of a communications medium. The second and third sentences only refer to the general

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type of destination network, such as a wireless LAN or WAN. The actual profile used on the network is not recited as a deciding factor in selecting the network.

Accordingly, from each of claims 1, 7, 12, 30, 36 and 41 are new matter.

Claims 2, 5-6, 8-11, 13-17, 31, 33-35, 37-40 and 42-50: Depend from the independent claims 1, 7, 12, 30, 36, 41 respectively.

Claim 51: Claim 51 has been newly added and recites “..a second attempt to establish communication via a remote wireless network if the first attempt fails..”. This feature is not supported in the original specification.

The discussion of the first, second and third attempts are illustrated in FIG. 8, and discussed in the specification at page 25. The relevant discussion from the specification reads as follows:

*“If, in step 274, the ICS module 304 determines the wireless LAN is out of range, it attempts to communicate via the cellular network in step 278.”*

Claim 51 states that if the first attempt fails, an attempt is made to contact a “remote wireless network”, which is not necessarily the same as the cellular network required in the specification. Accordingly, the recitation in claim 51 is broader in scope than what the original specification allows for, and thus the recited quotation in claim 51 is of new matter.

Allowable Claims: Claims 3, 4, 32 and 33 are allowed.

Remarks

Applicant's arguments have been considered.

Each of the independent claims and various dependent claims have been amended to change the word "protocol" to "profile" and applicant argues that this feature is supported by the discussion at pages, 8, 16 and 23 in the specification. While the specification does have the "word" profile used at these citations, the quotations cited at pages 8, 16 and 23 do not suggest the profile being utilized according to the steps set forth within independent claims 1, 7, 12, 30, 36 and 41. In particular, the quotations provided by applicant a communication medium being selected by a portable access device based on the communication profile. The quotations on pages 8 and 23 of the specification merely establish the existence of the profiles. The quotation on page 16 determine whether the profile is stored and a backup scenario used when the profile is not stored. None of the quotations pertain to any manner of selecting communications mediums and none of the quotations indicate that such selection is based on the profile itself. The examiner has additionally cited page 9 of the specification, where discussion is made of the parameters used to select a channel of service, but no mention is made of the profiles in this selection, and no mention is made of basing the actual selection on the profiles themselves. Accordingly, the feature of a communication medium selected by a portable access device based on the communication profile is new matter.

Claim 51 has additionally been rejected under 35 USC 112, first paragraph for containing new matter. The new matter issue here arises from the reference to a second attempt to establish communication via a remote wireless network. Applicant point to the specification at page 16,

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lines 20-23 which describes a fallback scheme as: local wireless Ethernet→remote wireless Ethernet→PSTN. Applicant argues that there is no new matter by reason that the term “remote wireless Ethernet” is not broader in scope than “remote wireless network”. This assertion is not correct. The claim terminology “remote wireless network” can encompass any network of any type of protocol, not just the Ethernet protocol. As a result, the claim is broader than what the specification permits. The examiner additionally considered the fallback scheme disclosed in FIG. 8 of the drawings, which is: wireless LAN→cellular transmission→landline. However, the “remote wireless network” set forth in claim 51 is broader in scope than the “cellular transmission” fallback arrangement. It should be noted that if applicant actually intends the fallback arrangement to include either “remote wireless Ethernet” or the “cellular transmission network” the terminology “remote wireless network” could be removed and replaced with these alternative terms in order to overcome the rejection.

This action follows the filing of an RCE request and is made non-final.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.



Sam Rimell  
Primary Examiner  
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